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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/689,124

10/20/2003

Mark H. Falahee

FLH-10902/29

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25006

7590

03/23/2009

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EXAMINER

YABUT, DIANE D

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARK H. FALAHEE

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Application No. 10/689,124  
Technology Center 3700

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Mailed: March 23, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on January 12, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

AMENDMENT AFTER FINAL

A review of the file indicates that on April 29, 2008, Appellant filed an Amendment After Final in response to the Final Rejection mailed October 29, 2007. It is not clear whether this Amendment has been considered because an Advisory Action has not been mailed. Clarification from the Examiner is required.

EXAMINER'S ANSWER, HEADINGS

A review of the file indicates that the Examiner's Answer mailed September 3, 2008 does not comply with the guidelines provided in § 1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007). Section 1207.02(A)(4) states:

(4) *Status of Amendments After Final.* A statement of whether the examiner agrees or disagrees with the statement of the status of amendments contained in the brief and an explanation of any disagreement.

While the examiner has stated that “the status of the amendments after final rejection contained in the brief is incorrect” [page 2], no explanation regarding the disagreement has been furnished. Correction is required.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading “New Grounds of Rejection” in the Examiner's Answer and must include

the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> Ed. Rev. 6, Sept 2007) for details.

While the Examiner's Answer mailed September 3, 2008 agrees with the statement appearing on page 1 of the Appeal Brief filed April 29, 2008 which states, in part, that "[c]laims 1-16 are pending, rejected and under appeal," the Examiner's Answer lists the "Grounds of Rejection" as follows:

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 102(e)  
as being anticipated by Palasis (U.S. Patent No. 6,689,103)  
[not numbered]; and

Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as  
Being unpatentable over Palasis (U.S. Patent No. 6,689,103)  
In view of DeSena (U.S. Patent No. 6,198,807) [not numbered]

It should be noted that the Final Rejection mailed October 29, 2007 and the Examiner's Answer mailed September 3, 2008 do not appear to include a rejection for claims 15 and 16. Appropriate correction is required.

### CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to appropriately respond to the Amendment After Final filed April 29, 2008;
- 2) to vacate the Examiner's Answer mailed September 3, 2008;

3) to generate a new Examiner's Answer which (1) corrects the "Status of Amendments After Final";<sup>1</sup> (2) sets forth the correct Grounds of rejection; and (3) corrects other sections of the Answer as may be required;

4) if appropriate, to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection);<sup>2</sup> and

5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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<sup>1</sup> If the Amendment filed April 29, 2008 is entered, appellant should be notified to submit a new Claims Appendix. An entire new Appeal Brief is not required.

<sup>2</sup> In Technology Center (TC) 3700, only a Director may approve new grounds of rejection.